

REMARKS

Claims 15-21 and 28-41 are currently pending in this application. In this response, claims 15, 28, 35, and 40 have been amended to clarify certain features of these claim to expedite prosecution of this application, and without prejudice to pursuing these claims in unamended or other forms in a continuation or other application.

In the Office Action mailed April 24, 2008, pending claims 15-21 and 28-41 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) Claims 15-21 and 28-41 were rejected under 35 U.S.C. §112 first paragraph;

(B) Claims 15-17, 19, 28-31, 34-37, and 39-41 were rejected under 35 U.S.C. §103(a) over the combination of U.S. Patent No. 6,289,140 to Oliver and U.S. Patent No. 6,111,604 to Hashimoto et al. ("Hashimoto");

(C) Claims 18, 32, and 38 were rejected under 35 U.S.C. §103(a) over the combination of Oliver, Hashimoto, and Maxium Technologies Internet Publication 2000 ("Maxium"); and

(D) Claims 20, 21, and 33 were rejected under 35 U.S.C. §103(a) over the combination of Oliver, Hashimoto, and U.S. Patent No. 5,764,779 to Haranishi ("Haranishi").

The undersigned attorney and his colleague, Aaron Poledna, wish to thank the Examiner for engaging in a telephone conference on June 25, 2008, to discuss the present Office Action, the Oliver and Hashimoto references, and the pending claims. During the telephone conference we discussed some of the distinctions between the pending claims and the teachings of Oliver and Hashimoto. The following remarks summarize and expand upon the points discussed during the June 25th telephone conference. Accordingly, the applicants request that this paper constitute the

applicants' Interview Summary. If the Examiner notices any deficiencies in this regard, he is encouraged to contact the undersigned attorney to correct such deficiencies.

A. Response to the Section 112 rejection of claims 15-21 and 28-41

Claims 15-21 and 28-41 were rejected under 35 U.S.C. §112 first paragraph for allegedly containing new matter. Without commenting on or conceding to the merits of the Section 112 rejection of these claims, claims 15, 28, 35, and 40 have been amended to address the Examiner's concerns and, accordingly, the Section 112 rejection of base claims 15, 28, 35, and 40 should be withdrawn.

Claims 16-21 depend from base claim 15, claims 29-34 depend from base claim 28, claims 36-39 depend from base claim 35, and claim 41 depends from base claim 40. Accordingly, the Section 112 rejection of these claims should be withdrawn.

B. Response to the Section 103(a) Rejection of Claims 15-17, 19, 28-31, 34-37, and 39-41 (Oliver and Hashimoto)

Claims 15-17, 19, 28-31, 34-37, and 39-41 were rejected under 35 U.S.C. §103(a) over the combination of Oliver and Hashimoto. The undersigned attorney thanks the Examiner for providing a detailed explanation of his position regarding these references during the June 25th telephone conference. For at least the reasons explained below, however, Oliver and Hashimoto cannot support a Section 103 rejection of claims 15-17, 19, 28-31, 34-37, and 39-41.

1. The Office Action has Failed to Establish that There is an Apparent Rational Reason to Combine Oliver and Hashimoto, and Has Thereby Failed to Establish a *Prima Facie* Case of Obviousness

The applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness for rejecting claim 15. To properly reject claims as obvious under Section 103, an Examiner must establish that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S. Ct. 1727 (2007). An Examiner's analysis "should be made explicit," and "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal standard of obviousness." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Moreover, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added).

The applicants respectfully submit that the Office Action lacks the articulated reasoning required by case law and therefore fails to present a *prima facie* case of obviousness and. More specifically, the Office Action fails to provide an articulated reasoning as to why it would have been obvious to modify Oliver according to the teachings of Hashimoto. For example, the Office Action simply states:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to generate a multimedia data file for transfer out of the camera of Oliver, when a "send" or "send all" command is said, so that the related image and sound data are always transferred and associated with each other at the destination location.

(Office Action, p. 6.) Such a conclusory statement does not satisfy the articulated reasoning standard required by recent case law. Although the Office Action mentions "so that the related image and sound data are always transferred and associated with each other," the Office Action has not provided any articulated reason for why it would be beneficial for doing so. Moreover, producing a single multimedia file based on the Office Action's conclusory statement "so that the related image and sound data are always transferred and associated with each other" appears to be an unfounded motivation to modify Oliver. Rather, Oliver has already contemplated a suitable method for associating the files by connecting the separate sounds and data files. For example, Oliver repeatedly states that the separate sound and data files are connected while they are stored, transferred, and accessed. (See, e.g., Oliver, 6:14-67.) Furthermore, as explained in detail below, combining the sound and data files into a single multimedia

file contradicts the specific teachings of Oliver, which includes separate sound and data files. Accordingly, for at least the foregoing reasons, the Office Action has failed to establish a *prima facie* case of obviousness, and the Section 103 rejection of claim 15 should be withdrawn.

2. One Skilled in the Art Would Not Modify Oliver According to the Teachings of Hashimoto

Claim 15 is further patentable over the combination of Oliver and Hashimoto because one skilled in the art would not modify Oliver according to the teachings of Hashimoto. As discussed during the June 25th telephone conference and as correctly noted in the Office Action at page 3, Oliver fails to disclose or suggest a multimedia data file producer that is configured to "produce a multimedia data file including image data derived from the first digital signal and sound data derived from the second digital signal," as recited in claim 15.

In contrast to producing a single multimedia file including combined image and sound data, Oliver specifically teaches storing an image file separately from a sound file. As discussed during the June 25th telephone conference, Oliver discloses that a "[c]ontroller 106 stores the voice annotation digital signal as a separate voice annotation file in static memory 116 and connects the image data file or document file with the voice annotation file." (Oliver, 6:14-17, emphasis added.) In addition to being stored separately, Oliver repeatedly teaches that the voice annotation file and image data file remain separated and are not combined when transferred to another device or accessed by a user. For example, Oliver teaches that when the files are transferred "[i]mage data files or document data files and the connected voice annotation files may be copied to another device, such as a host computer..." (Oliver, 6:28-30.) Moreover, when the files are accessed, Oliver teaches that "[a]fter hearing the audio information, the user may choose to view the image data file or document file." (Oliver, 6:62-64.) Allowing the separate access to the different sound and image data files enables the user to suspend the interface software for the purpose of retrieving the application program associated with the image data file to display the image data file. (Oliver, 6:64-67.)

To cure the above-noted deficiencies of Oliver, the Office Action relies on Hashimoto for "generat[ing] a multimedia data file for transfer of image and sound data out of an image pickup device." (Office Action, p. 3.) Even assuming for the sake of argument that Hashimoto discloses these features (and the applicants expressly do not), one skilled in the art would not modify Oliver in this manner because such a modification contradicts the specific teachings of Oliver. For example, Oliver specifically teaches storing, transferring, and accessing separate sound and image data files. Moreover, if Oliver's sound and image data files were combined, a user would not be able to choose to view the image data file after listening to the audio information.

In response to the fact that Hashimoto's teachings contradict those of Oliver, the Office Action asserts that "[t]his argument is not convincing since the image files in Hashimoto are also separate until they are sent from the camera." (Office Action, p. 2.) Whether or not the image and sound files are separate in Hashimoto until they are sent from the camera is moot, as the Office Action nonetheless relies on Hashimoto for teaching a processor that produces a single multimedia data file comprising combined image and sound information. (Office Action, p. 5.) However, for at least the reasons explained in detail above, one skilled in the art would not modify Oliver in such a manner. Therefore, the Section 103 rejection of claim 15 should be withdrawn.

Claims 16-21 depend from allowable base claim 15. Accordingly, the Section 103 rejection of claims 16-21 should be withdrawn for at least the reasons discussed above with reference to base claim 15, and for the additional features of these dependent claims.

Independent claims 28, 35, and 40 include several features generally similar to those of claim 15 (e.g., a multimedia data file producer configured to produce a multimedia data file including image data and sound data). Accordingly, the Section 103 rejection of claims 28, 35, and 40 should be withdrawn for at least the reasons discussed above with reference to claim 15, and for the additional features of these independent claims.

Claims 29-34 depend from allowable base claim 28, claims 36-39 depend from allowable base claim 35, and claim 41 depends from allowable base claim 40. Accordingly, the Section 103 rejection of claims 29-34, 36-39, and 41 should be withdrawn for at least the reasons discussed above with reference to their respective base claims, and for the additional features of these dependent claims.

C. Response to the Section 103(a) Rejection of Claims 18, 32, and 38 (Oliver, Hashimoto, and Maxium)

Claims 18, 32, and 38 were rejected under 35 U.S.C. §103(a) over the combination of Oliver, Hashimoto, and Maxium. Claim 18 depends from base claim 15, claim 32 depends from base claim 28, and claim 38 depends from base claim 35. The Office Action relies on Maxium for disclosing that the image sensor is a contact image sensor. Maxium, however, fails to cure the above-noted deficiencies of Oliver and Hashimoto to support a Section 103 rejection of base claims 15, 28, and 35. For example, Maxium fails to disclose or suggest a multimedia data file producer that is configured to produce a multimedia data file including image data derived from the first digital signal and sound data derived from the second digital signal. Accordingly, claims 18, 32, and 38 are allowable over the combination of Oliver, Hashimoto, and Maxium for at least the reason that these references, either alone or in combination, fail to teach or suggest the features of base claims 15, 28, and 35, and the additional features of corresponding dependent claims 18, 32, and 38. Therefore, the Section 103 rejection of claims 18, 32, and 38 should be withdrawn.

D. Response to the Section 103(a) Rejection of Claims 20, 21, and 33 (Oliver, Hashimoto, and Harnanishi)

Claims 20, 21, and 33 were rejected under 35 U.S.C. §103(a) over the combination of Oliver, Hashimoto, and Harnanishi. Claims 20 and 21 depend from base claim 15, and claim 33 depends from base claim 28. The Office Action relies on Harnanishi for disclosing a microphone including a filter for filtering off a noise signal from the analog signal. Harnanishi, however, fails to cure the above-noted deficiencies of Oliver and Hashimoto to support a Section 103 rejection of base claims 15 and 28. For example, Harnanishi fails to disclose or suggest a multimedia data file producer that

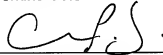
is configured to produce a multimedia data file including image data derived from the first digital signal and sound data derived from the second digital signal. Accordingly, claims 20, 21, and 33 are allowable over the combination of Oliver, Hashimoto, and Harmanishi for at least the reason that these references, either alone or in combination, fail to teach or suggest the features of base claims 15 and 28, and the additional features of corresponding dependent claims 20, 21, and 33. Therefore, the Section 103 rejection of claims 20, 21, and 33 should be withdrawn.

Conclusion

In view of the foregoing, the pending claims comply with 35 U.S.C. § 112 and are patentable over the applied art. The applicants accordingly request reconsideration of the application and a mailing of a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact Cameron Pilling at (206) 359-6123.

Respectfully submitted,

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